

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

APR 04 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN W. MASTERS,
MATTHEW PIETRAFITTA
and
THERESE VELDE

Application 09/944,315

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on March 8, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith electronically returned to the examiner. The matters requiring attention prior to docketing are identified below.

An examination of the file reveals that an Information Disclosure Statement (IDS) was filed on June 30, 2003. The Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 2, May 2004) § 609 states:

(C) (2) Complying Information Disclosure
Statements

The information contained in information disclosures statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 will be considered by the examiner. . . .

Examiners must consider all citations submitted in conformance with the rules and this section, and their initials when placed adjacent to the considered citations on the list or in the boxes provided on a form PTO-1449 or PTO/SB/08A and 08B provides a clear record of which citations have been considered by the Office. . . . Those citations not considered by the examiner will have a line drawn through the citation.

The IDS filed June 30, 2003 is deficient because it is not apparent whether Patent Abstracts of Japan vol. 017, no. 383 (E-1400), 19 July 1993 (1993-07-19) & JP 05 064296 A (Terumo Corp), 12 Mar. 1993 (1993-03-12) Abstract (listed under "Other Prior Art") have been considered by the examiner. A communication notifying appellants of the Examiner's decision regarding these references is required.

In addition, on May 4, 2004, appellants filed a Notice of Appeal and an Appeal Brief. On August 19, 2004, an Examiner's Answer was mailed in response to the Appeal Brief. On August 12,

2004, the "Rules of Practice before the Board of Patent Appeals and Interferences" were printed in the Federal Register (69 Fed. Reg. 49959, final rule). These rules became effective on September 13, 2004. A Reply Brief was filed under the new rules on September 21, 2004 (§ 41.41). Section 41.43 reads as follows:

§ 41.43 Examiner's response to reply brief.

(a) (1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications.

In response to the Reply Brief filed September 21, 2004, the Examiner mailed a paper entitled "Detailed Action" (hereinafter Supplemental Examiner's Answer). The examiner must follow the guidelines set forth in training material entitled "Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule," located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

The Supplemental Examiner's Answer mailed January 31, 2005 is deficient because the signature of a TC Director, Special Programs Examiner (SPRE), or Quality Assurance Specialist (QAS) has not been obtained. Correction is required.

Accordingly, it is

ORDERED that the application is returned to the examiner:

1. for consideration of the "Other Prior Art" (Patent Abstracts of Japan vol. 017, no. 383 (E-1400), 19 July 1993 (1993-07-19) & JP 05 064296 A (Terumo Corp), 12 Mar. 1993 (1993-03-12) Abstract) listed on the IDS filed June 30, 2003 and notification to appellants regarding the Examiner's decision;

2. for obtaining the signature of a Director, SPRE, or QAS on the Supplemental Examiner's Answer mailed January 31, 2005;

3. for written communication to appellants regarding the action taken; and

4. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
DALE M. SHAW
Program and Resource Administrator
(571) 272-9797

DMS/psb/ts

cc: Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830